

Application No.: 10/622,445  
Atty. Docket No.: 54525.000102

Reply to Office Action of October 12, 2005

### Remarks

Claims 2-12 are pending in the application. Claims 2 and 4-12 were rejected in the Office Action, while claim 3 was objected to. Applicants appreciate the Examiner's reasoned and articulate action. However, Applicants respectfully request that the Examiner reconsider the rejections set forth in the action in light of the remarks below.

### ***Rejection of Claims 2, 4-6 and 8-11 Under 35 U.S.C. § 102***

#### Popik, et al.

Claims 2, 4, 6, 8, 9 and 11 were rejected under 35 U.S.C. § 102(e) as allegedly being anticipated by U.S. Patent No. 6,568,089 to Popik, et al. ("Popik"). Office Action, p. 2. In order for Popik to anticipate claims 2, 4, 6, 8, 9 and 11, Popik must teach every element of each of claims 2, 4, 6, 8, 9 and 11. *See* MPEP § 2131; *see also*, *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631 (Fed. Cir. 1987). Applicants respectfully contend that Popik does not teach every element of each of claims 2, 4, 6, 8, 9 and 11.

Claims 2 and 8 each recite the limitation of "the *reciprocating shaft also having a bore formed in a second end opposite the first end, . . . and a first end of the bearing being positioned inside the bore*" (emphasis added). FIG. 8 of the application shows an embodiment of the invention having this limitation. Paragraph 0076 of the specification describes this embodiment and a unique advantage of this embodiment over prior art designs.

[0076] The reciprocating shaft 160 is supported in the pivot housing 150 by a rear *internal bearing which is more compact than rear bearings in prior art designs*. In this

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embodiment, the bearing comprises a guide pin 180. With reference again to FIG. 8, one end of guide pin 180 forms an exterior bearing surface 181. The guide sleeve 162 forms another interior bearing surface 165 on the reciprocating shaft 160. Guide pin 180 has threads on its opposite end which engage complementary threads formed in a bore 156 (FIG. 7) to mount the guide pin to the pivot housing 150.

U.S. Patent Application Publication No. 2004/0049928, ¶ 0076 (emphasis added). Accordingly, claims 2 and 8 require that the reciprocating shaft have a bore in its second end and that a first end of the bearing must be position inside the bore.

In contrast, Popik does not disclose a reciprocating shaft having a bore formed in an end and a bearing end positioned inside the bore. As the Examiner observes, Popik does disclose a reciprocating shaft (541) and fixed bearings (545), referred to as "yoke pins" by Popik. Popik, col. 7, l. 13. However, an end of the bearing is not positioned in a bore in the shaft. Rather, the yoke pins engage a T-shaped head (542) that is connected to the reciprocating shaft by a pin (544). *Id.* col. 6, ll. 57-60. While the T-shaped head does have bores that pass through it, these bores are not formed in an end of the reciprocating shaft (541). For at least these reasons, Applicants respectfully submit that Popik does not disclose all the elements of claims 2 and 8 and, therefore, does not anticipate claims 2 and 8.

#### O'Banion

Claims 2, 4, 6, 8, 9 and 11 were rejected under 35 U.S.C. § 102(b) as allegedly being anticipated by U.S. Patent No. 4,385,443 to O'Banion ("O'Banion"). Office Action, p. 2. As discussed above, in order for O'Banion to anticipate claims 2, 4, 6, 8, 9 and 11, O'Banion must teach every element of each of claims 2, 4, 6, 8, 9 and 11. Applicants respectfully contend that O'Banion does not teach every element of each of claims 2, 4, 6, 8, 9 and 11.

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As also discussed above, claims 2 and 8 each recite the limitation of “the reciprocating shaft also having a bore formed in a second end opposite the first end, . . . and a first end of the bearing being positioned inside the bore.” O’Banion does not disclose a reciprocating shaft having a bore formed in an end and a bearing end positioned inside the bore. As the Examiner noted, O’Banion shows a reciprocating shaft (4), called a saw blade carrier. O’Banion, col. 2, ll. 35-38. However, the saw blade carrier does not have a bore at a second end. Rather, “[t]he saw blade carrier 4 is guided in an elongate bushing 5 in the housing 1 for movement in longitudinal direction . . . .” *Id.* col. 2, ll. 39-41. The bushing (5) is not a part of the saw blade carrier (4) but rather a bushing in which the saw blade carrier rides. *Id.* Additionally, the rods (20) are not bearings on which a shaft reciprocates. They form part of a biasing means that maintains engagement of the drive mechanism. *See id.* col. 3, ll. 17-33 and col. 4, ll. 27-53. For at least these reasons, Applicants respectfully submit that O’Banion does not disclose all the elements of claims 2 and 8 and, therefore, does not anticipate claims 2 and 8.

#### Forsberg

Claims 2, 4-6 and 8-11 were rejected under 35 U.S.C. § 102(b) as allegedly being anticipated by U.S. Patent No. 2,639,737 to Forsberg (“Forsberg”). Office Action, p. 3. In order for Forsberg to anticipate claims 2, 4-6 and 8-11, Forsberg must teach every element of each of claims 2, 4-6 and 8-11. Applicants respectfully contend that Forsberg does not teach every element of each of claims 2, 4-6 and 8-11.

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Again, as discussed above, claims 2 and 8 each recite the limitation of "the reciprocating shaft also having a bore formed in a second end opposite the first end, . . . and a first end of the bearing being positioned inside the bore." Forsberg does not disclose a reciprocating shaft having a bore formed in an end nor a bearing end positioned inside the bore. As the Examiner noted, Forsberg teaches a reciprocating shaft (51), called a saw ram, and bearings (46), called guide rods. Forsberg, col. 4, ll. 1, 11. However, Forsberg is similar to Popik in that the saw ram does not have a bore. Rather, the guide rods (46) engage a "crosshead" (43) similar to the T-shaped head of Popik. Forsberg, col. 3, ll. 60-75. The same arguments articulated above with regard to Popik also apply to Forsberg, and Applicants respectfully submit that Forsberg does not disclose all the elements of claims 2 and 8 and, therefore, does not anticipate claims 2 and 8.

Applicants believe, for at least the reasons stated herein, that Popik, O'Banion and Forsberg do not anticipate claims 2 and 8. Additionally, Applicants believe that claims 2 and 8 are not obvious over Popik, O'Banion or Forsberg. Embodiments of the claimed invention offer significant advantages over the prior art taught by Popik, O'Banion and Forsberg including, at least, the advantage of making the rear bearing more compact than the rear bearings in these prior art designs.

Applicants believe that claims 2 and 8 are allowable and respectfully request that the rejection of these claims be withdrawn. Additionally, claims 3-6 depend from claim 2, and claims 9-11 depend from claim 8. Therefore, claims 3-6 and 9-11 should be patentable for at least the same reasons as those discussed above with respect to claims 2 and 8.

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***Rejection of Claims 7 and 12 Under 35 U.S.C. § 103***

Claims 7 and 12 were rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Popik or O'Banion. Office Action, p. 3. Claim 7 depends from claim 2, and claim 12 depends from claim 8. As discussed above, Applicants respectfully submit that claims 2 and 8 are not obvious in light of Popik or O'Banion, and therefore, the added limitations of claims 7 and 12 would not be obvious. Accordingly, Applicants respectfully traverse the rejection of claims 7 and 12 and request that the rejection of these claims be withdrawn.

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### Conclusion

Applicants believe that all of the rejections in the Office Action have been addressed by the remarks above. Given that the claims pending in the application have been finally rejected, Applicants sincerely welcome a telephone call or interview with the Examiner and the undersigned Applicants' representative.

If any additional fees are due, the Commissioner is authorized to debit those fees from the undersigned's Deposit Account No. 50-0206.

Respectfully submitted,

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